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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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James A. Parker

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03/07/2006

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/915,719	<b>Applicant(s)</b> PARKER, JAMES A.	
	<b>Examiner</b> Joseph R. Maniwang	<b>Art Unit</b> 2144	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27,29-33,37,38 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27,29-33,37,38 and 44-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 1-13, 16-21, and 44 is withdrawn upon further consideration of the claims. Rejections based on a new interpretation of the claim language follow.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 9, 21, 37, 38, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The term "linguistic equivalent" in claims 8, 9, 21, 37, and 38 is a relative term which renders the claim indefinite. The term "linguistic equivalent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is thus unclear as to what Applicant is claiming as the invention, since the term "linguistic equivalent" provides no definite recitation of any limitation.

### ***Claim Rejections - 35 USC § 101***

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5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 14, 15, 22-27, 29-33, 37, 38, 44-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Regarding claims 14 and 45-48, "A data storage medium comprising indicia of instructions for a processor to perform a method for managing access to a file, via an electronic message, the method comprising: displaying...; designating...; transmitting...; and...transmitting..." would normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

8. Regarding claim 15, "A system for managing access, via an electronic message, to a file maintained within a first domain, the system comprising: means for identifying...; and means for transmitting..." is non-statutory, since it is not tangibly embodied in a manner so as to be executable, as the only hardware is in an intended use statement. This is true even if the various means include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware. Additionally, Applicant defines such various means as software modules, and therefore the various means are not tangibly embodied (see Specification, p. 5, paragraph [0022]).

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9. Regarding claims 22-24, "A data storage medium comprising indicia of instructions for a processor to perform a method...the method comprising: causing...; and causing..." would normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

10. Regarding claim 25, "An electronic message system comprising: an electronic message program...; means for causing..." is non-statutory, since it is not tangibly embodied in a manner so as to be executable, as the only hardware is in an intended use statement. This is true even if the recited program and means include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware. Additionally, Applicant defines such means as software modules, and therefore the various means are not tangibly embodied (see Specification, p. 5, paragraph [0022]).

11. Regarding claims 26-27, "A propagated signal embodied in a message-encoded data stream having a series of data frames..." is non-statutory as not being tangibly embodied in a manner so as to be executable.

12. Regarding claims 49-52, "A data storage medium comprising indicia of instructions for processor to perform a method for managing access, via an electronic message, to a file maintained within a first domain, the method comprising..." would

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normally be considered statutory unless the Specification defines "data storage medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, Applicant defines a "data storage medium" as including software (see Specification, p. 5, paragraph [0022]).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-27, 29-33, 37, 38, 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma.

15. Yamaguchi disclosed a method and system for managing access, via an electronic message, to a file maintained within a first domain, the system comprising means for identifying addresses of one or more recipients of the message (see paragraph [0052], [0068]) and designating each recipient as having viewing or editing privileges of the file (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); and means for transmitting the electronic message to the recipients

within one or more domains distinct from the first domain such that any recipients designated as file viewers and recipients designated as file editors can access the file, and any recipients designated as file editors can modify the file (see paragraph [0069], [0103]). Yamaguchi further disclosed a method and system comprising accepting one or more file accessor addresses (see paragraph [0052], [0068]); for each address, determining an authorization status as either authorized for direct file access or not authorized for direct file access (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); transmitting the electronic message to the addresses within at least a second domain distinct from the first domain (see paragraph [0069], [0103]); and for each electronic message sent to a file accessor address not so authorized, transferring data of the file as an attachment to the electronic message (see paragraph [0069]).

16. While Yamaguchi disclosed transferring the electronic message to the recipients, Yamaguchi did not specifically disclose transmitting the electronic message without transferring the file out of the first domain with the electronic message. Yamaguchi did not specifically disclose for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message.

17. In a related art of electronic messaging, Kuzma disclosed a method and system for transmitting e-mail over a network. Kuzma disclosed sending attachment files by reference, wherein the e-mail message itself comprised an attachment reference such as a hyperlink (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33).

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Thus, Kuzma disclosed transmitting attachment data separately from an e-mail message.

18. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for identifying recipients of an electronic message as having viewing/editing privileges, transmitting the electronic message to the recipients without transferring the file with the electronic message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for displaying an e-mail message window comprising a plurality of recipients fields for recording which recipient addresses were authorized to view an attachment or edit the attachment, including the provision for transmitting the attachment separately from the e-mail message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly



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recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits.

### ***Response to Arguments***

19. Applicant's arguments filed 11/02/05 and 04/08/05 have been fully considered but they are not persuasive.

20. Applicant traverses the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), and further in view of Kuzma (U.S. Pat. No. 5,771,355).

21. Regarding claims 15, 16, 22, 25, and 26, Applicant asserts that Yamaguchi relies upon message recipient fields to differentiate between file viewers and file editors (see Remarks 04/08/05, p. 19), and is thus less flexible than the claimed invention which allows authorization to a file independent of designation of a recipient. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., authorization of a recipient independent of being designated a message recipient) are

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not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Examiner submits that the use of the various message recipient fields to differentiate between file viewers and file editors as recognized by Applicant (see Remarks 04/08/05, p. 19) reads upon the broad concept of further including a file viewer field and a file editor field as claimed.

22. Regarding claim 29, Applicant asserts that the references do not teach transmitting data of a file in different ways to address different needs defined in the Specification, such as “accommodating policies that prohibit persons outside an organization’s local area network from accessing files directly,” etc. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., transmitting data of a file in different ways to address different needs) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner submits that the broad limitations recited in claim 29 are taught by the prior art of record.

23. Regarding claims 1 and 14, Applicant asserts that Yamaguchi does not teach “the use of distinct fields to record indicia identifying viewers or editors authorized to view or modify a file accessed via an electronic message in addition to the use of a field indicating addresses to which the electronic message is being sent”. However,

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Examiner submits that, as acknowledged by Applicant, Yamaguchi reads upon the broad concept of using separate distinct fields to designate access rights as it was disclosed that several distinct fields could be used to control access rights to a file. Furthermore, Examiner submits that the use of distinct fields to designate authorized viewers/editors of a file is not claimed as argued. The claims require "accepting message addresses by performing at least one of the following actions: recording, in the first field, indicia identifying one or more addresses to which the electronic message is to be transmitted". Yamaguchi clearly reads upon this claim language as it was disclosed that a message window included a "TO:" field (see paragraph [0052]).

24. Applicant traverses the rejection of claims 14-15, 22-25, and 45-52 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicant asserts that the Specification at paragraph [0022] does not define the term "data storage medium" to include intangible media and that the final sentence provides examples of "shared storage media" such as RAM or a hard disk, which are tangible media. However, Examiner submits that one of ordinary skill in the art supplied with the Specification including the recitation of paragraph [0022] could reasonably interpret the claimed "data storage medium" as software. The Specification describes functional modules within each computer's dashed box (see Fig. 1), each of which "can be suitably implemented by hardware, software, or both". Clearly, Fig. 1 depicts storage elements (114, 144, 174) that could be considered "data storage medium" since, as stated by Applicant, the term is not defined in the Specification. Thus, since all elements in Fig. 1 can be suitably implemented by software, it can be reasonably interpreted that the claimed

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“data storage medium” includes intangible media such as software. Furthermore, although Applicant asserts that “shared storage media” includes a tangible RAM or hard disk, it is also stated in the Specification that “shared storage media” can include “arguments and returned values” and “files” (see paragraph [0022]). Examiner submits that the same reasoning applies to Applicant's assertion that the various claimed “means” of claims 15 and 25 are not software per se. Finally, regarding claims 26 and 27, Examiner submits that the propagated signal claimed is clearly non-statutory subject matter and remains rejected under 35 U.S.C. 101.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carter et al. (U.S. Pat. App. Pub. 2002/0105545)

Shaw et al. (U.S. Pat. No. 6,247,045)

Theimer et al. (U.S. Pat. No. 5,493,692)

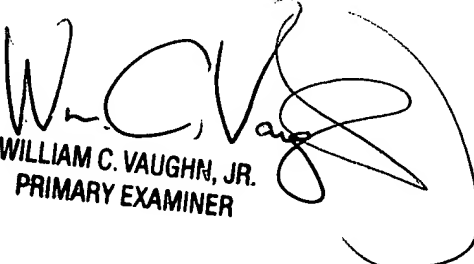
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

  
WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER